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1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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5  
6 BEFORE THE PATENT TRIAL AND APPEAL BOARD  
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8  
9 *Ex parte* NEREIDA MARIA MENENDEZ, PAULA S. WILLIAMS, and  
10 MICHAEL J. MANIS.  
11

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13  
14 Appeal 2012-010607  
15 Application 09/698,502  
16 Technology Center 3600  
17

18  
19 Oral Hearing Held: January 24, 2013  
20

21  
22 Before ANTON W. FETTING, MICHAEL W. KIM, and  
23 NINA L. MEDLOCK, *Administrative Patent Judges*.  
24

25 APPEARANCES:  
26

27 ON BEHALF OF THE APPELLANTS:  
28

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35 The above-entitled matter came on for hearing on Thursday, January  
36 24, 2013, commencing at 9:00 a.m. at the U.S. Patent and Trademark Office,  
37 600 Dulany Street, Alexandria, Virginia before John Mongoven, Notary  
38 Public.

1 P-R-O-C-E-E-D-I-N-G-S

2

3 JUDGE FETTING: Good morning Counsel.

4 MR. VOLK: Good morning.

5 JUDGE FETTING: Okay, this is Calendar Number 96, Appeal  
6 Number 2012-010607. The Application is Number 09/698502.

7 My name is Judge Fetting. With me on the bench are Judges  
8 Kim and Medlock. We are familiar with the record, so you have 20 minutes.  
9 You can begin when you're ready.

10 MR. VOLK: Okay, great. My name is Ben Volk I'm here to  
11 discuss the Appeal of the claim rejections in the 09/698502 case. And I felt  
12 it might be helpful to start by explaining the invention a bit.

13 This invention is a technique by which a rental vehicle  
14 reservation is converted into an electronic rental contract. And this  
15 electronic rental contract permits the customer to avoid going to the counter  
16 to create that rental contract when they pick up their rental vehicle in  
17 accordance with the transaction.

18 And importantly, the method and system are designed such that  
19 these steps of creating the electronic rental contract are performed regardless  
20 of whether the customer has a preexisting master rental agreement with the  
21 rental car company.

22 JUDGE FETTING: Why is that important? You say

1 importantly.

2           MR. VOLK: It greatly expands the universe of users who are  
3 able to bypass the counter. And it also changes the nature of the interactions  
4 with the software where you don't have to supply the system with a MRA  
5 number. The system doesn't need to know who you are before you interact  
6 with them.

7           JUDGE FETTING: The system still needs to know who you  
8 are. I mean, even in your specification, the customer says who they are.  
9 They provide their name and address.

10          MR. VOLK: I guess before the transaction, the system does not  
11 need to know who you are.

12          JUDGE FETTING: Okay. Before you create a master rental  
13 agreement, whatever that is, the system doesn't need to know who you are  
14 either. I mean, in either case the user has to enter information about who  
15 they are.

16          MR. VOLK: Correct. But with a master rental agreement  
17 you're going to have to go through more steps to bypass your transaction  
18 with the rental car company.

19          And one of those big ones, you have to fill out the master rental  
20 agreement with the rental car company, get that all completed, filed, enrolled  
21 and then at some point when that enters their system, you're able to then use  
22 your master rental agreement to expedite transactions. With this system,

1 without any prior interaction with the rental car company, you can go in over  
2 the internet, book your reservation, turn your reservation into an electronic  
3 rental contract and bypass the rental counter.

4 JUDGE FETTING: What is in the master rental contract that's  
5 not in the transaction or vice a versa?

6 MR. VOLK: The master rental agreement versus --

7 JUDGE FETTING: Aside from the number, the identifying  
8 number?

9 MR. VOLK: Yes, versus the reservation? Because a  
10 reservation does not entitle a customer to actually get in the car and go. A  
11 rental car company's going to require that you actually have a rental  
12 agreement with them, a rental contract with them before they let you drive  
13 away in the car.

14 So reservations are usually varied, it's almost a skeleton amount  
15 of information. It's name, location, time and type of car. Even type of car  
16 sometimes is not necessarily required.

17 So with a master rental agreement, what they're getting from the  
18 customer are agreements as to various terms as to what happens with  
19 cancellations. With a typical master rental agreement's going to have a term  
20 in there where the customer gets charged even if they're a no show.

21 There's going to be credit card information and credit card  
22 authorizations to be charged for the transaction.

1 JUDGE FETTING: Now they're going to have to enter all that  
2 information even in your system as well. They need to have a credit card  
3 number, there are going to be terms associated with it.

4 So I think what the examiner and we are having trouble with is,  
5 it's not really clear what calling a set of data a master rental agreement does?  
6 It just seems to be a marketing name. It doesn't seem to distinguish what's  
7 going on.

8 MR. VOLK: Well, it's the preexisting factor again. It's the fact  
9 that the customer already has to have this master rental agreement with the  
10 rental car company in the prior art before they can even expedite the  
11 transaction.

12 JUDGE FETTING: Yes, that's a matter of policy not a  
13 technology, presumably.

14 MR. VOLK: Well but the --

15 JUDGE FETTING: It's a marketing tool, that's all a master  
16 rental agreement is, is a marketing tool. It develops a sense of affinity with  
17 the rental company. But I mean, again, you have to provide all that  
18 information.

19 MR. VOLK: I guess, yes. But another aspect, I guess the  
20 master rental agreement against the credit card, the credit card authorization,  
21 it's the driver's license identification. That presumably gives the rental car  
22 company the opportunity to verify all that before they enroll the customer

1 with the master rental agreement.

2               With the invention all that's being done online and in real time  
3 as the customer books the reservation. And then when they convert the  
4 reservation into the electronic rental contract a screen is going to be  
5 provided to the customer where they provide credit card information,  
6 driver's license information.

7               There could be a validation operation performed on that  
8 information and it can be approved as a real time transaction to let the  
9 customer again bypass the counter even though the rental car company did  
10 not know about that customer before they started the transaction.

11              JUDGE FETTING: True, but the rental car company knew  
12 about the transaction long before the customer came to pick up the car.  
13 Because they had to enter all the information into the web long before they  
14 came to pick up the car.

15              MR. VOLK: Picking up the car, but in terms of the creation of  
16 the electronic rental contract, that's done before the customer, that can be  
17 done before the customer arrives at the rental car location to pick up their  
18 car.

19              JUDGE FETTING: Right. But the record shows that Hertz  
20 does that. You're simply arguing that Hertz happens to use a master rental  
21 agreement?

22              MR. VOLK: Yes, Hertz uses a preexisting master rental

1 agreement.

2 JUDGE FETTING: Right.

3 MR. VOLK: And then when you then go to their website to  
4 make your reservation, if you want to leverage that master rental agreement  
5 to bypass the counter, you have to enter your master rental agreement  
6 number into the screen. And if it matches their records, they're going to let  
7 you kind of go straight to the car. But again, it requires that preexisting  
8 relationship with Hertz.

9 JUDGE FETTING: Right. Now the way your claim is drafted,  
10 there can be a master rental agreement. It's just that it's not required.

11 MR. VOLK: Yes, so --

12 JUDGE FETTING: And in fact in some of your dependent  
13 claims, you even use some of the information from the master rental  
14 agreement.

15 MR. VOLK: Yes.

16 JUDGE FETTING: So clearly you're not saying not use, you're  
17 just saying that you don't have to use it?

18 MR. VOLK: Yes. And so the technology of the software  
19 essentially removes that requirement of preforming, requiring that the  
20 customer provide a master rental agreement and then also writing a check on  
21 that master rental agreement before they'll let the customer --

22 JUDGE FETTING: Well, that's the technology that, I mean



1 again, you're just enter basically the information. What's the technological  
2 difference?

3 MR. VOLK: It's the removal of the requirement that the  
4 customer --

5 JUDGE FETTING: That's a policy difference, that's not a  
6 technological difference. What is different about the software that makes it  
7 so that you don't have to have that master rental agreement?

8 MR. VOLK: Again, it is I think, I believe a technical  
9 difference to remove the MRA requirement. But also, and some of the  
10 dependent claims address this, I believe it's --

11 JUDGE FETTING: By the way, I've read the Hertz references  
12 and I fail to see where it says it's required. It says that they use their  
13 customers, but nothing says there's a technological requirement.

14 Certainly not technological requirements, only a marketing.  
15 They choose to only offer this to the members of their number one club. But  
16 that's a promotional choice, that's not a technological constraint as far as I  
17 can see.

18 JUDGE FETTING: We have a dependent claim. For example  
19 Claim 74, Claim 124 as well as 76 and 126 that talk about, during the  
20 transaction we're also, while the transaction is going we're validating their  
21 driver's license and validating their credit card authorization.

22 And that's another technological change that facilitates the

1 ability to take a customer who you've never seen before --

2 JUDGE FETTING: Right.

3 MR. VOLK: -- and let them --

4 JUDGE FETTING: You have, Counsel. I mean that  
5 technology has been extant for 50 years. I mean police have been using that  
6 technology and I can only imagine that rentals cars have been using this as  
7 well.

8 But we all know that the police have been using this kind of  
9 technology for 50 years at least. So that's not new technology.

10 MR. VOLK: Isolated it is not but in combination with this  
11 rental process flow it is new --

12 JUDGE FETTING: It's certainly predictable. Everybody  
13 knows you're going to have to provide a driver's license and a credit card.  
14 And the use of credit card pads have been around for 60 years, probably.

15 And again, the driver's license is, in view of watching, you  
16 know, 10,000 cop shows on television, where police routinely find out  
17 whether a driver's license is valid in real time. It's got to be predictable.

18 MR. VOLK: Again, but there's no, in there rental car industry  
19 this was not done.

20 JUDGE FETTING: But that's a matter of custom and  
21 promotion. That's not a technological distinction. It certainly does not show  
22 that one of ordinary skill did not know that you could do it.

1 MR. VOLK: There's I guess no evidence in the record that  
2 there was knowledge of ordinary skill in the art about that. And especially  
3 about the combination with the rental process flow to let a customer, who  
4 does not have a preexisting master rental agreement with the rental car  
5 company, to bypass that rental counter.

6 JUDGE FETTING: Okay, we understand your position. Let's  
7 move on.

8 MR. VOLK: Okay. And the appeal brief brings this out but the  
9 Hertz reference, the examiner cited a Hertz reference, an Avis reference and  
10 a Hertz Gold reference.

11 The Hertz and Avis references describe a website through  
12 which you can book a reservation. But they don't describe that follow-on  
13 step of creating the electronic rental contract.

14 And the Hertz Gold reference was cited by the examiner toward  
15 those later steps of creating the electronic rental contract. And if you look at  
16 the evidence in the record, it does demonstrate that the Hertz Gold reference  
17 is just saying if you're a member of the Hertz frequent renter club, you book  
18 four rentals, you can get a free upgrade offer where they waive their  
19 membership fee into Hertz number one, called Gold.

20 But it still requires the customer to fill out a master rental  
21 agreement, send it off the Hertz and get enrolled in the program before they  
22 can bypass the counter.

1 I just had a couple of comments on the indefiniteness rejections.  
2 There were two rejections under 112, second paragraph. And the first one,  
3 the examiner took a position that the claims were not clear as to who the  
4 master rental agreement was between.

5 And on that we disagree because the claims clearly cite that the  
6 master rental agreement is between a rental car company and the customer.  
7 The rental car company that operates the car rental facility and the customer.  
8 And so we believe the claims are clear as to who the parties are to the master  
9 rental agreement.

10 And the other 112 rejection was based on some statements by  
11 the examiner where he was requiring whether something was done during  
12 "same session." And we believe that's immaterial to the scope of the claims.

13 Claim 62 doesn't have a same session requirement with regard  
14 to it. And because there's not a same session requirement in the claim, the  
15 examiner's statements about same session we believe are immaterial to scope  
16 and don't make the claims indefinite.

17 JUDGE FETTING: Is there a lexicographic definition of a  
18 master rental agreement in the specification?

19 MR. VOLK: There is not. It's kind of relaying on the, kind of  
20 the commonly understood term for that in the rental car industry.

21 And again, that's kind of the preexisting agreement you have  
22 with the rental car company. It kind of serves as a, instead of using the word

1 master rental agreement, you might call it an umbrella agreement or a  
2 blanket agreement.

3           It's a preexisting agreement that's meant to encompass a large  
4 series of later transactions. Common master rental agreement situations like  
5 Acme Corporation enters into master rental agreement with, let's say with  
6 Alamo.

7           And from that master rental agreement their employees can  
8 book reservation with certain rates and certain cars, et cetera. So that's good,  
9 that's the master rental agreement.

10           JUDGE FETTING: Okay. Can you wrap it up, we're almost  
11 out of time?

12           MR. VOLK: Okay, yes. A couple of comments on some  
13 dependent claims that are also, we believe independently patentable. Claim  
14 65 and 115 talk about a choice that is provided to the customer through this  
15 path where when they are completing their reservation.

16           They're provided with the option to just make the reservation or  
17 continue on. It's kind of a reservation or rent option.

18           If the select the rent option they can go through immediately  
19 and do their electronic rental contract then. If they select the reservation  
20 only option they can only create the reservation.

21           But then they can still later go back into the system and do a  
22 electronic rental contract. Which means, yes, you can make a reservation

1 way in advance and then closer to your pickup time you can actually make  
2 your rental contract, so you can bypass the counter.

3           Claim 66 and 116 provide another feature where, let's say you  
4 pick that reservation only option from the reservation rental button and you  
5 get a confirmation email about your reservation, there's going to be a link in  
6 that email that lets you then later enter the electronic rental contract creation  
7 path. And that's kind of facilitating again, letting a customer book their  
8 reservation far in advance.

9           And then when they're certain they're going to pick up their car  
10 day before, they can make their rental contract and pick it up at the counter.  
11 Or sorry, pick it up at the location without going to the counter.

12           Again, we talked a little bit about Claim 74, 76 which talk  
13 about doing the driver's license validation and the credit card validation in  
14 line with the process. And then dependent Claim 139 speaks of the specific  
15 situation where the user in fact does not have a preexisting master rental  
16 agreement with the rental car company.

17           JUDGE FETTING: Okay, I have no further questions. Judge  
18 Kim, do you?

19           JUDGE KIM: No.

20           JUDGE FETTING: Judge Medlock?

21           JUDGE MEDLOCK: No.

22           JUDGE FETTING: Okay, Counsel, we'll take your comments

1 under advisement.

2 MR. VOLK: All right, thank you for your time.

3 JUDGE FETTING: Thank you very much.

4 (Whereupon, the hearing in the above-entitled matter was  
5 adjourned at 9:17 p.m.)

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